

### Remarks

The undersigned attorney notes with appreciation the allowance of claims 1-27.

The examiner has rejected claim 28 under 35 U.S.C. 103 (a) as being unpatentable over U.S. Patent 3,811,305 to Saylor Jr., hereinafter Saylor. This rejection is not thought to be well taken.

The examiner states:

Saylor discloses an apparatus for providing decaling liquid to a metal strip comprising: a first array of nozzles normally positioned to spray full width of passing metal strip (figure 1), a second array of nozzles normally in a position remote from the passing metal (figure 4). Saylor fails to disclose a second array of nozzles in a maintenance position. It would have been obvious to one having ordinary skill in the art to utilize the raised inoperative position (figure 4) as suggested by Saylor for servicing and maintenance the array of nozzles. Doing so would lessen equipment downtime due to servicing and repairing.

First, it should be noted that claim 28 requires two separate and distinct arrays of spray nozzles, the first array normally being in a position to spray the full width of a passing strip and movable to a maintenance station, and the second being normally positioned in a maintenance station and movable to a position to spray the full width of a strip. The reason for two distinct arrays of nozzles is avoid interrupting the function of the spray descaling of a continuous strip of metal. If there is a malfunction of one or more nozzles in the first array, the second array of nozzles can be moved into position to continue spray descaling, while the first array of nozzles is moved to the maintenance station, and the necessary maintenance performed while maintaining the operation of the line. This is described in some detail in the specification at page 6, line 20, through page 7, line 10. It is submitted that Saylor discloses only one set of nozzles, not two that are each maintained at different stations. Moreover, while Saylor does move his nozzles toward and away from the sheet of metal being sprayed, he gives no indication that the away position could be used to perform maintenance. Indeed, from a review of the drawings, that does not

DYC-10-5565

appear to be feasible. However, even if it were feasible, this would still not teach the applicants' claim of two separate arrays of nozzles, each array being at a different location. In Saylor, if the one of the nozzles is non-functioning, there is no spray descaling taking place since there is not another set of nozzles to take its place when the non-functioning nozzle is removed for maintenance. In applicants' case, spray descaling takes place even if one or more nozzles in one set of nozzles is non-functioning.

It is not enough that one may modify a reference, but rather it is required that a second reference suggest such modification of the first reference.

The CAFC stated In re Piasecki, 745 F.2d 1468, 223 USPQ 785, 788 (Fed. Cir. 1984) the following:

"The Supreme Court in Graham v. John Deere Co., 383 U.S. 1 (1966), focused on the procedural and evidentiary processes in reaching a conclusion under Section 103. As adapted to ex parte procedure, Graham is interpreted as continuing to place the "burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under sections 102 and 103". Citing In re Warner, 379 F.2d 1011, 1020, 154 USPQ 173, 177 (CCPA 1967)."

The law is quite clear that in order for a claimed invention to be rejected on obviousness, the prior art must suggest the modifications sought to be patented; In re Gordon, 221 U.S.P.Q. 1125, 1127 (CAFC 1984); ACS Hospital System, Inc. v. Montefiore Hospital, 221 U.S.P.Q. 929, 933 (CAFC 1984). The foregoing principle of law has been followed in Aqua-Aerobic Systems, Inc. v. Richards of Rockford, Inc., 1 U.S.P.Q. 2d, 1945 (D.C. Illinois 1986). In the Aqua-Aerobic's case, the Court stated that the fact that a prior reference can be modified to show the claimed invention does not make the modification obvious unless a prior reference suggests the desirability of the modification.

In In Re Oetiker, 24 U.S.P.Q. 2nd 1443, 1445 (CAFC 1992) held:

"There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge can not come from the applicant's invention itself."

Most significantly, the CAFC in the recent case of In Re Dembiczak, 50 U.S.P.Q.2<sup>nd</sup>

1614 (CAFC 1999) held at 1617:

"...(examiner can satisfy burden of obviousness in light of combination 'only by showing some objective teaching [leading to the combination]');"

Thus, it is clear that where an individual reference does not teach the entire invention, then the modification which the invention represents must be suggested and motivated by some other reference through some objective teaching and cannot come from the application itself, which is not the case here since there is but one reference cited. Hence, there clearly can be no suggestion of modifications in any way, let alone as suggested by the Examiner. Thus, since claim 28 claims this feature, it is clearly allowable over Saylor.

The reference cited but not applied has been reviewed, and it is not believed to be any more pertinent than the Saylor reference.

In view of the above it is respectfully requested the examiner allow claim 28, along with claims 1-27.

Respectfully submitted,

Date: 7-24-03

  
William N. Hogg (Reg. No. 20,156)  
Driggs, Lucas, Brubaker & Hogg Co., L.P.A.  
8522 East Avenue  
Mentor, Ohio 44060  
(440) 205-3600  
Fax: (440) 205-3601  
e-mail: bill@driggslaw.com

WNH:cg

DYC-10-5565

FAX RECEIVED

JUL 28 2003

GROUP 3700